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Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

UNITED STATES SURGICAL CORPORATION,
Petitioner,

v.

ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITIONER'S REPLY BRIEF

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REPLY ARGUMENT

Ethicon cannot dispute that U.S. Surgical raised the *Markman* issue [1] below, and that the appellate panel did not apply the holding of *Markman* in this case. Nor is Ethicon able to advance any rational reason why this case should be treated any differently than *Markman* with regard to the issue of patent claim construction. Faced with these facts, Ethicon repeatedly mischaracterizes the *Markman* issue as a "minor tangent" of U.S. Surgical's case below, Ethicon Brief ("Eth. Br.") at 7, 9, and tries to argue the absence of prejudice, *id. at* 8-9, 13. Ethicon is wrong on both counts; U.S. Surgical clearly pressed the *Markman* issue both at trial and on appeal, and was severely prejudiced.

1. U.S. Surgical Squarely Presented The *Markman* Issue In The Courts Below

The trial history shows that U.S. Surgical, based on *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992), persuaded the initial judge that he was required to define the scope and meaning of the claims for the jury, only to find that the judge later assigned to try this case, relying on *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*, 945 F.2d 1546, 1549-50 (Fed. Cir. 1991), accepted the contrary view.[2] U.S. Surgical continued to press its position, as the trial judge expressly noted in his post-trial ruling: "At trial, U.S. Surgical urged the court to instruct the jury on the meaning of the four patent claims at issue." Petitioner's Appendix ("P.A.") 24a.

U.S. Surgical submitted detailed instructions to the trial court supporting its position on the patent claims' mean-

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[1] *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3068 (U.S. July 3, 1995) (No. 95-26).

[2] Ethicon asserts that the trial judge followed "then-controlling Federal Circuit precedent," Eth. Br. at 6, but CAFC precedent was in conflict, and *Read* was surely the stronger precedent, as the CAFC held in *Markman*.

ing. P.A. 24a, n.26.[3] Had the trial judge followed *Read* instead of *Tol-O-Matic*, these instructions would have been given.[4] The trial judge rejected meaning-specific instructions in favor of boilerplate instructions. R.A. 1a-4a.

On appeal, U.S. Surgical's major premise was that the trial court should have defined the claims' meaning for the jury as a matter of law, and that its failure to do so deprived U.S. Surgical of a meaningful patent trial. P.A. 44a-45a. As U.S. Surgical argued, one consequence of the trial court's abdication of its role as law-giver was the jury's request for a dictionary. P.A. 44a-45a.

In its opening brief on appeal, U.S. Surgical argued that it was entitled to prevail on obviousness and '057 infringement but, failing that, was entitled to a new trial because of the trial court's failure to define the scope and meaning of the claims for the jury. Ethicon's Appendix ("Eth. A."), A-7, A-9 to A-10, A-16. Having highlighted this issue in its summary of argument, and having staked its position squarely on the correctness of *Read*, U.S. Surgical argued that the trial court abdicated its responsibility under *Read*.[5] U.S. Surgical also reiterated this position in its CAFC Reply Brief. U.S. Surgical CAFC Reply Brief at 1, 18-20.[6]

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[3] These instructions are reproduced in the appendix to this brief, Reply Appendix ("R.A.") 5a-26a.

[4] Ethicon's argument that the requested instructions contained error, Eth. Br. at 12, is both incorrect and irrelevant, since any dispute would have been resolved at the instructional stage.

[5] In its appellate brief, U.S. Surgical set up the refusal of the trial court to instruct the jury on the scope and meaning of the claims in its statement of the case, and stressed the issue's importance in its new trial argument on obviousness. Eth. A, A-7, A-9 to A-10 ("and, to compound the problem, refused to construe the meaning of the claims for the jury"). U.S. Surgical reiterated this position in support of its new trial argument on '057 infringement. Eth. A, A-16.

[6] U.S. Surgical concluded its reply argument as follows: "The Court's limited charge on claim construction, comprising less than

Given U.S. Surgical's emphasis on the trial court's failure to define the meaning of the claims, it is irresponsible for Ethicon to assert, Eth. Br. at 7, that the question of who construes the claims "was a minor tangent in U.S. Surgical's appeal brief." To the contrary, the fundamental flaw throughout the patent trial was the court's refusal to tell the jury what the patent claims meant. That was the reason U.S. Surgical chose this issue as a major theme of its argument. P.A. 44a-45a.[7]

2. U.S. Surgical Was Prejudiced On Obviousness By The Trial Court's Failure To Define The Scope And Meaning Of The Claims [8]

As Ethicon advised the CAFC:

> There was a sharp dispute at trial on how a person of ordinary skill in the art would construe the claims. To be sure, each side's experts thought that the meaning of the claims was clear—but they construed the claims in ways that could not have been more divergent.

Ethicon's CAFC Answering Brief at 28-29. The CAFC has long recognized that failure to define the scope and meaning of patent claims is prejudicial error in "obvious-

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two pages of abstract statements of law, A. 676-77 (Tr. 2732-34), was no substitute for meaning-specific instructions. That the parties set forth divergent views of the claims in testimony and charts, Eth. 29-30, only underscores the need for accurate instruction. Far from providing 'meticulous instructions,' Eth. 30, the District Court ignored its obligation to instruct the jury on the meaning of the claims." U.S. Surgical CAFC Reply Brief at 20.

[7] Ethicon erroneously argues that the CAFC "selected" *Markman*, as opposed to this case, as the vehicle for *en banc* consideration of the roles of court and jury in claim construction. Eth. Br. at 11. The CAFC ordered rehearing *en banc* in *Markman* on November 5, 1993, months before this case was tried in the District Court in January 1994.

[8] Ethicon apparently concedes that U.S. Surgical was prejudiced on the '057 infringement issue. U.S. Surgical prevailed on '420 infringement. Ethicon's argument of no prejudice focuses only on obviousness.

ness" analysis; definition is imperative in order to compare the claimed invention with the prior art. *See, e.g., Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir.) ("When the prior art is compared with erroneously interpreted claims, findings of differences between the prior art and the claims will necessarily be clearly erroneous."), *cert. denied*, 481 U.S. 1052 (1987). U.S. Surgical sought specific instructions defining its patent claims, so that the jury could compare properly-construed claims to the prior art for the purpose of determining "obviousness." R.A. 5a-17a, 19a-26a; Eth. A., A-9 to A-10. This did not happen. The prejudice to U.S. Surgical was that the jury, in a case in which claim meanings were sharply disputed, was allowed to determine obviousness without being instructed on what the claims meant. Equally important, the jury had no opportunity to develop an appreciation for the specific limitations of U.S. Surgical's patent claims, as U.S. Surgical had urged. U.S. Surgical detailed its position on prejudice in its CAFC Brief. Eth. A, A-9 to A-10.[9]

A patent is born valid and carries with it a presumption of validity, 35 U.S.C. § 282, which may be rebutted only by clear and convincing evidence. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810 (1986). Without properly defined claims, an infringer's task on obviousness becomes substantially easier, because the jury is more likely to accept generalized assertions that the Patent Office mistakenly allowed claims that were too

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[9] Ethicon also asserts that U.S. Surgical's patent law engineering experts agreed that prior art open clip appliers would constitute the claimed invention if they were merely sealed and had a long shaft. Eth. Br. at 4. U.S. Surgical's experts, however, clearly testified that simply desiring an instrument having the claimed features was not enough to make the claims obvious; one also would have had to know how to make the claimed instrument, as taught by U.S. Surgical's patents. A. 455 (Tr. 1533); A. 386 (Tr. 1157-58). U.S. Surgical's engineering expert noted that "no one could get to an endoscopic multiple." A. 386 (Tr. 1158). *See* n.10, *infra*.

broad and therefore obvious from the prior art. On the other hand, if the scope and meaning of the claims are defined by the court, it is more difficult for an infringer to use arguments not tied to the claim's limitations to induce an obviousness verdict.

In this case, Ethicon took maximum advantage of the trial court's failure to define the claims' scope and meaning. Ethicon asserts that U.S. Surgical sought a broad claim interpretation "to try to preempt the entire field by advocating the broadest possible construction of the claims." Eth. Br. at 3. As U.S. Surgical pointed out below, Eth. A., A-9, this was *not* U.S. Surgical's position; it was the way Ethicon repeatedly and abusively mischaracterized U.S. Surgical's position. It was Ethicon, the infringer, that strenuously resisted U.S. Surgical's efforts to have the trial court define the claims, so that Ethicon could argue in closing, as it repeatedly did, R.A. 27a, that U.S. Surgical's claims had no boundaries and therefore were obvious from the prior art. Ethicon thereby induced an improper verdict of obviousness.

Ethicon further asserts that U.S. Surgical was not prejudiced by the trial court's failure to define the claims, because U.S. Surgical's proposed instructions broadly claimed "a long, sealed version of a generic multiple clip applier." [10] Ethicon argues that had U.S. Surgical's proposed instructions been given, the jury would have found the invention obvious anyway. Eth. Br. at 3-6, 11. While one cannot know what construction the jury gave the patent claims, the instructions requested by U.S. Surgical belie Ethicon's argument. These instructions show that U.S. Surgical undertook to review each claim and re-

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[10] Ethicon cannot dispute that U.S. Surgical's ENDO CLIP™ was an important technological feat. Ethicon's trial witnesses were certainly of this view. *See, e.g.*, A. 520 (Tr. 1892); A. 582 (Tr. 2247) (Ethicon's engineering expert testified: "The invention of a particular configuration of multiple endoscopic multiple clip applier, and its reduction through engineering to a merchandisable product is not obvious.").

quested the trial court to define the meaning of each claim element for the jury, including the specific mechanical structures identified by each claim element. R.A. 5a-17a, 19a-22a. For example, properly construed, the "means for closing clips" required a pair of flexible opposing jaws, not *any* jaws as Ethicon argued. *Compare* R.A. 7a-8a, 12a, 19a-20a (U.S. Surgical's proposed instructions) *with* R.A. 27a (Ethicon's closing argument) *and* R.A. 28a (U.S. Surgical's closing argument).[11] The instructions, if given, clearly would have conveyed to the jury that the claims were a combination of specific structural elements in an endoscopic instrument and that their particular combinations, not some general concept, had to be found obvious.[12]

In short, U.S. Surgical suffered the well recognized prejudice flowing from an obviousness determination without proper claim construction, compounded by the infringer's improper argument that the claims, in the abstract and without any definition, were too broad and therefore obvious from the prior art.

3. This Court Should Grant Certiorari Or Hold This Case In Abeyance Pending *Markman*

Ethicon argues that the CAFC rejected U.S. Surgical's petition for rehearing *en banc* on the claim construction issue knowing the outcome of *Markman*, because it concluded that U.S. Surgical was not prejudiced by the trial

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[11] To counter Ethicon's improper arguments, U.S. Surgical also introduced into evidence a commercial endoscopic multiple clip applier (PX 228) made by Origin (Eli Lilly) which, unlike Ethicon's product, did not have a pair of flexible opposing jaws. Thus, the Origin product did not have all the specific structures of U.S. Surgical's claims, as properly construed, and therefore did not infringe those claims. The purpose was to show the fallacy of Ethicon's overbroad assertions of claim scope. But the jury, without the claims being defined for it, never developed an appreciation that there were well-defined limits on the reach of the claims.

[12] That is why the Patent Examiner allowed the claims; he was fully familiar with open clip applier art and, of course, knew that endoscopic instruments had to be long and sealed.

court's refusal to define the claims for the jury. Eth. Br. at 12-14. This is sheer speculation totally lacking in merit. Under Circuit Rule 36, the CAFC will not entertain an *en banc* petition from a panel's summary disposition. Such disposition removes any opportunity for *en banc* consideration, because a petitioner cannot identify points of law or fact overlooked or misapprehended by the panel. Fed. R. App. P. 40(a); Circuit Rule 40 (b)(2). That is the very mischief resulting from the procedures followed by the panel below that needs this Court's attention.

4. The Federal Circuit's Decision On The Dictionary Issue Conflicts With All Known Precedent

It is universally acknowledged that a jury's consultation of a non-evidential dictionary is error. Certainly, there are cases in which trial and appellate courts have concluded, *based on knowledge of the word or words looked up by the jury* and comparing them with the court's instructions, that a new trial was not warranted. *See, e.g., United States v. Cheyenne*, 855 F.2d 566 (8th Cir. 1988); *Connectiut v. Asherman*, 478 A.2d 227, 252 (Conn. 1984), *cert. denied*, 470 U.S. 1050 (1985). Even in those cases, however, giving a dictionary to the jury is condemned. *See, e.g., Asherman*, 478 A.2d at 252.[13] Courts often conclude that a new trial is required. *See, e.g., Wernsing v. General Motors Corp.*, 470 A.2d 802, 809 (Md. 1984). But, so far as petitioner is aware, there is no case in which a new trial was not ordered when, as in this case, the jury made use of a dictionary, the words or words looked up are unknown, and the trial

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[13] Like Ethicon, the trial judge relied on *Asherman* (a Connecticut state court case) to justify having given the dictionary to the jury. P.A. 30a. But *Asherman* warns against giving the jury a dictionary, relying on *Oregon v. Holmes*, 522 P.2d 900, 905 (Or. Ct. App. 1974), a case directly on point. In *Holmes*, prejudice was presumed and a new trial ordered, because the trial court provided the jury with a dictionary over both parties' objections and the words looked up were unknown.

court declined to hold a hearing to ascertain what words were looked up by the jury.

Ethicon argues, as it did below, that the dictionary was not extraneous, because its submission during the jury's deliberations was the functional equivalent of a court exhibit being given to the jury as permitted under Rule 614, Fed. R. Evid. Eth. Br. at 15. This argument is flatly contrary to the fundamental evidentiary principle that a jury should base its decision "on proofs taken openly at the trial, free from all danger of extraneous influences." *Palestroni v. Jacobs*, 77 A.2d 183, 185 (N.J. Super. Ct. App. Div. 1950) (Brennan, J.) (a dictionary case) (quotation omitted).

Ethicon asserts that U.S. Surgical never presented the CAFC with a "credible hypothesis on how submission of the dictionary might have prejudiced it." Eth. Br. at 17. As U.S. Surgical pointed out in the CAFC (and also in the trial court), under controlling Second Circuit precedent the burden was on Ethicon, not U.S. Surgical, to rebut the presumption of prejudice arising from the jury's use of a dictionary. U.S. Surgical's CACF Brief at 45-47. In addition, U.S. Surgical showed in its opening CAFC brief that words of likely interest to the jury, such as "obviousness" and "presumption" (as used in "presumption of validity"), have markedly different meanings in the patent world than they do in *Webster's New World Dictionary*. *Id.*

In short, the dictionary was non-evidential matter. In affirming the trial court, the CAFC necessarily rejected application of the presumption of prejudice, in direct conflict with the Second Circuit's controlling decision in *United States v. Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985). The CAFC decision also conflicted with the many federal and state court decisions ordering new trials when, as in this case, there was no factual basis for concluding that the jury's use of the dictionary was not prejudicial. This issue is particularly important in patent cases, in which the meaning of words

in a patent often are determinative of the outcome not only of the obviousness analysis, but of infringement as well.

5. Ethicon's Rule 606(b) Argument Is Specious

Relying on Rule 606(b), Fed. R. Evid., Ethicon argues that the trial court would not have been allowed to discover the word or words examined by the jury. Ethicon is wrong. It is *settled* law that Rule 606(b) does *not* forbid a juror from testifying that he or she consulted a dictionary. *See, e.g., United States v. Duncan*, 598 F.2d 839, 866 (4th Cir.) ("juror may testify that she had consulted a dictionary and related her findings to the group" under Rule 606(b)), *cert. denied*, 444 U.S. 871 (1979). Rather, Rule 606(b) prevents inquiry only into the effect that the use of extraneous material had on the jury's deliberations. 598 F.2d at 866. In dictionary cases, courts routinely find out, typically by consulting the jurors, what word or words were looked up, but do not inquire into how the definitions affected their deliberations. The court decides whether a new trial is required by comparing the word or words as defined by the dictionary with the jury charge.

6. The CAFC Improperly Invoked Circuit Rule 36 To Decide This Case

> The most important and most typical indication of the rationality of the judicial function is the reasoned opinion.[14]

The trial court in this case made clearcut errors of law that precluded the CAFC from invoking Circuit Rule 36. P.A. 46a (Rule 36(e)). As was clear under *Read* and now *Markman*, the trial court erred in not deciding the scope and meaning of the claims as a matter of law prior to submitting the case to the jury. The trial court also clearly erred in submitting the dictionary to the jury over both parties' objections. The trial court again erred by not construing the claims after trial, on U.S. Surgical's

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[14] Piero Calamandrei, *The Crisis in the Reasoned Opinion, in* THE LAW AS LITERATURE 683, 683 (Ephraim London ed., 1966).

JMOL motion. If the CAFC regarded these trial errors as nonprejudicial, it had an obligation to inform U.S. Surgical, which brought these errors of law to the CAFC's attention, of its reasoning regarding them as not prejudicial.[15] The appellant's statutory right to judicial review, as much as the need for regularity in the appellate process, required the CAFC to issue a written opinion in these circumstances.

This case seems to be a prime example of the CAFC improperly using Circuit Rule 36 to avoid its obligation of appellate review. The petition for *certiorari* pending in *Pirkle v. Ogontz Controls Co.*, No. 95-45, at 17-23 (U.S. filed July 10, 1995), further documents the CAFC's misuse of Rule 36, and shows that it is not an isolated practice. The CAFC's Rule 36 practice is worthy of this Court's consideration, given that the effect is to deprive appellants of their statutory right of judicial review. This Court's review of this issue would provide much needed guidance to the CAFC, and benefit other courts of appeal as well.

7. The Public Importance Of This Case

Ethicon does not challenge the exceptional public importance of resolving the respective roles of the court and jury in ascertaining the scope and meaning of patent claims in jury trials, a question that arises repeatedly. When, as in this case, a trial court fails to perform this essential role and allows numerous disputes over claim scope and meaning to go to the jury, there is no escape from the need for a new trial because the process by which the jury reached its decision is unknown and unworkable, and therefore unreviewable for error of law.

CONCLUSION

The petition for a writ of certiorari should be granted.

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[15] Circuit Rule 36 also permits summary affirmance only when an opinion "would have no precedential value." P.A. 46a. A written opinion on the dictionary issue would have conflicted with every state and federal court that had considered the issue.

Respectfully submitted,

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APPENDICES

APPENDIX A

DISTRICT COURT'S INSTRUCTIONS CONCERNING CLAIM INTERPRETATION (Feb. 10, 1994)

Let me introduce you to the issues in this case. In this case U.S. Surgical is the owner of United States letter patents number 5,084,057 and number 5,100,420, both entitled apparatus and method for applying surgical clips in laparoscopic and endoscopic procedures. I will refer to these as the '057 and the '420 patents. U.S. Surgicial asserts that Ethicon has infringed claims 1, 2 and 7 of the '057 patent and claim 1 of the '420 patent, by making, using and selling endoscopic multiple clip appliers known as the LIGACLIP ERCA and the LIGACLIP EMCA.

Now, in response Ethicon denies that its devices infringe upon the claims of U.S. Surgical's patents. Ethicon also affirmatively asserts that the U.S. patent surgical patents are invalid because the inventions claimed in the patents were obvious.

What now follows is an explanation of the method you should use and the factors you should consider in order to reach your verdict on the various issues in this case. It is important that you follow the instructions in their entirety and that you proceed with the analysis in the exact order that I've set it out for you. Before you make any decisions, you should read these instructions, and as I've said, you'll have them with you in the jury room, and be certain that you understand them.

Now, for each of claims 1, 2 and 7 of the '057 patent and claim 1 of the '420 patent you should do the following:

First you must construe each one of the patent claims at issue and then you should answer this question: Has U.S. Surgical met its burden of proving by a preponderance of the evidence that the EMCA and ERCA sold

by Ethicon infringe either claims 1, 2 or 7 of the '057 patent or claim 1 of the '420 patent?

Second, you should answer the following question for each claim at issue in the case: Has Ethicon met its burden of proving by clear and convincing evidence that the claims are invalid?

Let's talk a little about patent infringement. In order to succeed on its claim for patent infringement, U.S. Surgical must prove, again by a preponderance of the evidence, that the Ethicon devices infringe upon the claims.

The determination of infringement is a two step process. First, you must determine the meaning of the language of the claims. Second, you must compare the Ethicon device to the language of the claims, as you've interpreted them, in order to determine whether the Ethicon device contains each element of the patent claims. Patent claims can be infringed either literally, which means that the accused device includes each element of the patent claims, or under the Doctrine of Equivalents.

Now, the interpretation, let's talk about the interpretation of claims. The patent claims are the numbered paragraphs at the end of the patent. The claims involved here are claims 1 of the '420 patent and claims 1, 2 and 7 of the '057 patent, and you have each been furnished a copy of these patents and we will see to it that you obviously have copies of these patents with you. The claims describe the words the parameters of the invention. Each claim has various subparts or claim elements. In order to infringe a claim, each element of the claim must be infringed. If any one claim of a patent is infringed, then the patent may be said to be infringed.

Because I have determined that there's a factual dispute here concerning the meaning of the patent claims, you must determine how the claims in this patent should

be interpreted. You should interpret the language of the claim as one of ordinary skill in the art would do.

In interpreting the language of the claims you should consider:

One, the ordinary meaning of the language used in the claim;

Two, the specifications in the patent;

Three, the prosecution history of the patent;

Four, the other claims in the patent;

Five, the prior art in the field.

Now, in this case you have heard expert testimony concerning how those skilled in the art would interpret the claims. You may also rely on this expert testimony in determining the meaning of the patent claims.

As you have learned, there are two types of claim elements in U.S. Surgical's patents: Structure elements and means plus function elements. Whether a claim element is a structure element or a means plus function element will affect how you interpret that particular claim element.

A stucture element identifies a specific structure. In interpreting a structure element, you need only determine what structure is defined by the language of the claim.

A means plus function element describes a means for performing a certain function. When means plus function claims are used, the patent does not protect every structure or component that can be used to perform that function. Rather, means plus function claims must be interpreted to include only the structures described in the patent specifications for perfoming the given function or their equivalent. Therefore, to interpret a means plus function element, you must determine what structure or structures are described in the patent specifications for performing each such function and what structures would constitute their equivalent.

After you have determined the meaning of the claims at issue, you can move on to the next step, comparing the accused devices to the claims as you have interpreted them.

APPENDIX B

U.S. SURGICAL'S PROPOSED INSTRUCTIONS CONCERNING THE CLAIMS AT ISSUE AND THEIR MEANING
(District Court, Feb. 2, 1994)

B. *Meaning of U.S. Surgical's Claims*

1. *Claim 1 of the '420 Patent (PPI 37)*

Claim 1 of the '420 Patent reads in full: In combination:

a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity;

b) an endoscopic clip applier having:

i) a frame;

ii) an endoscopic portion, defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through said valve means in sealing engagement therewith, said endoscopic portion further including a plurality of surgical clips disposed in any array and clip closing means for sequentially closing said surgical clips; and

iii) seal means associated and adapted to cooperate with at least one of said endoscopic portion and said frame to obstruct passage of gaseous media from the body cavity.

This claim covers the combination of "a) a trocar having a cannula, and valve means for sealing said cannula, said cannula adapted for entry into a body cavity." Claim element a) calls for a trocar having a cannula with valve means for sealing the cannula. The claim element "valve means for sealing said cannula" is a means-plus-function claim element. The stated function, as I interpret it, is to seal the cannula. The struc-

ture for performing this function includes all such structures contained in trocars known in the art at the time the '420 Patent Application was filed. Such trocars contain structures both to seal the cannula when no instrument is in the cannula, such as a flapper-type valve, and structures which form a seal between the instrument and the cannula when an instrument is inserted in the cannula, such as a gasket. The flapper valve may engage the gasket, as in the U.S. Surgical Surgiport Trocar, or be separate from the gasket, as in reusable instruments that were known at the time the '420 Patent Application was filed. Therefore, if you find that the Ethicon Endopath Trocar is a trocar having the same or equivalent structure to the structures I have just described, then the accused devices satisfy claim element a) of Claim 1 of the '420 Patent.

The next claim element is claim element "b) an endoscopic clip applier" having the further elements identified in parts b)i), b)ii), and b)iii). I interpret the word "endoscopic" in the phrase "endoscopic clip applier" to refer generally to instruments having elongated and relatively narrow operating portions for insertion into a cannula or a small wound in the skin.

The next claim element—b) i)—calls for "a frame." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices include a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The initial clause of the next claim element—b) ii)—recites "an endoscopic portion defining a longitudinal axis and extending distally from said frame, said endoscopic portion being insertable into said cannula through

said valve means in sealing engagement therewith." I interpret this structure claim element to mean an endoscopic portion extending away from the frame which can be inserted through the trocar cannula so that the cannula valve means forms a seal around the endoscopic portion. Therefore, if you find that the defendants' accused devices contain an endoscopic portion extending away from the frame which can be inserted through a trocar cannula so that the cannula valve means forms a seal around the endoscopic portion, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The next clause of claim element b) ii) recites "said endoscopic portion further including a plurality of surgical clips disposed in an array." I interpret this structure claim element to mean that more than one clip is stored in the endoscopic section of the claimed instrument. For purposes of this claim, it is immaterial how the clips are stored. Therefore, if you find that numerous clips are stored in the endoscopic portion of defendants' accused devices, regardless of how they are stored, then defendants' accused devices satisfy this element of Claim 1 of the '420 Patent.

The final clause of claim element b) ii) calls for "clip closing means for sequentially closing said surgical clips." This is a means-plus-function claim element. The stated function of this particular means-plus-function claim element is "sequentially closing said surgical clips." I interpret this to mean the closing of surgical clips one at a time and one after another. The structure or "means" described in the patent specification for performing the stated function is a pair of flexible opposing jaws which are cammed together into closure by a distally moving channel.

In order to find that this claim element of the '420 Patent has been met, you must first find that the defendants' accused devices perform the function of closing surgical clips one at a time and one after another. Then you

must find that the defendants' accused devices have a pair of flexible opposing jaws and a distally-moving cam channel, or equivalent structure, which perform this function. One example of equivalent structure, as I explained earlier, is structure which a person of ordinary skill in the art would consider as interchangeable with the structure disclosed in the patent specification for performing the stated function.

The final claim element of Claim 1 of the '420 Patent reads as follows: "seal means associated and adapted to cooperate with at least one said endoscopic portion and said frame to obstruct passage of gaseous media from the body cavity." This claim element is also stated in means-plus-function language. The stated function, as I interpret it, is to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. It is not the stated function to prevent all gas from escaping. The structure or "means" described in the patent specification for performing this function is close tolerances for the internal moving parts of the endoscopic portion, and/or a seal block with or without silicone grease.

In order to find that this claim element of the '420 Patent has been met, you must first find that the defendants' accused devices perform the function of obstructing the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Then you must find that the defendants' accused devices utilize close tolerances for the internal moving parts of the endoscopic portion, and/or a seal block with or without silicone grease, or equivalent structure, which perform this function.

If you find that defendants' Endopath trocar and EMCA/ERCA devices meet all of the limitations recited in the claims, and that defendants have made, used or sold

a combination of such a trocar and EMCA/ERCA, then Claim 1 is infringed.

2. *Claim 1 of the '057 Patent (PPI 38)*

Claim 1 of the '057 Patent reads in full:

An apparatus for endoscopic application of surgical clips to body tissue which comprises:

a) frame means;

b) endoscopic means connected to said frame means of generally elongated configuration and extending distally from said frame means and including:

i) means for storing a plurality of surgical clips;

ii) means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped;

iii) means for at least partially closing each said clip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means; and

iv) gaseous sealing means.

Claim 1 uses the preamble and transitional phrase "An apparatus for endoscopic application of surgical clips to

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'420 Patent, Col. 15, lines 36-48 (claim element 1a)); '420 Patent, Col. 1, lines 47-51 (claim elements 1a) & 1b)—combination of endoscopic clip applier and trocar); '420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68, Figure 2 (claim element 1b)i)—frame); Col. 3, line 29 and 54, Col. 4, line 13 (claim element 1b)ii)—endoscopic portion insertable into cannula); Col. 4, lines 23-25, Col. 8, line 66 (claim element 1b)ii)—clip closing means for sequentially closing said surgical clips); Col. 4, line 64—Col. 5, line 1, Col. 5, lines 4-17 (claim element b)iii—seal means); Trial Testimony of Basam E. Nabulsi, Esq., pp. 708-716 (discussing meaning to person of ordinary skill in art of corresponding structure for valve means claim element).

body tissue which comprises." I interpret the words "an apparatus for endoscopic application of surgical clips to body tissue" to mean an endoscopic multiple clip applier. Therefore, if you find that defendants' accused devices are endoscopic multiple clip appliers, then the preamble of Claim 1 of the '057 Patent has been met. As I explained earlier, the word "comprises" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended. The presence of additional components in the accused product is irrelevant to whether the product infringes the patent claim. Therefore, if you find that defendants' accused devices contain all of the elements in Claim 1 and, in addition, defendants' accused devices contain additional components, defendants' accused devices still infringe the claim.

Claim element 1a) reads "frame means." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices have a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

The initial clause of the next claim element—1b)—reads "endoscopic means connected to said frame means of generally elongated configuration and extending distally from said frame means." I interpret this structure claim element to mean an endoscopic portion connected to the frame and extending away from the frame. Therefore, if you find that the defendants' accused devices have an endoscopic portion connected to the frame and extending away from the frame, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

Claim elements 1b)i), 1b)ii), 1b) iii), and 1b)iv) are further elements which are part of and included in the endoscopic portion.

Clause i) of claim element 1b) reads "means for storing a plurality of surgical clips." This is a means-plus-function claim element. The stated function, as I interpret it, is to store a plurality of surgical clips. The structure or means disclosed in the patent specification for performing this function is a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument.

In order to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of storing a plurality of surgical clips. Then you must find that the defendants' accused devices have a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument, or equivalent structure, which perform this function.

Clause ii) of claim element 1b) reads "means for individually advancing said clips to the distal portion of said endoscopic means for positioning adjacent the body tissue to be clipped." This is a means-plus-function claim element. The stated function, as I interpret it, is to advance clips one at a time to the jaws. The structure or means described in the patent specification for performing this function is a pusher bar and escapement tabs extending into the path of the clips.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of advancing clips one at a time to the jaws. Then you must find that the defendants' accused devices have a pusher bar and escapement tabs extending into the path of the clips, or equivalent structure, which perform this function.

Clause iii) of claim element 1b) reads "means for at least partially closing each said clip at least sufficient to grip the body tissue after the clip has been advanced distally to said distal portion of said endoscopic means." This is a means-plus-function claim element. The stated function, as I interpret it, is to at least partially close surgical clips sufficiently to grip body tissue. The structure or means described in the patent specification for performing this function is flexible opposing jaws and a distally moving cam channel.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of at least partially closing surgical clips sufficiently to grip body tissue. Then you must find that the defendants' accused devices have flexible opposing jaws and a distally moving cam channel, or equivalent structure, which performs this function.

The final clause iv) of claim element 1b) reads "gaseous sealing means." I interpret this as a structure claim element which requires a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Therefore, if you find that defendants' accused devices contain a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed, then defendants' accused devices satisfy this element of Claim 1 of the '057 Patent.

'057 Patent, Abstract, 420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68 (claim element 1a)—frame means); 057 Patent, Col. 5, lines 11-13 (claim element 1b)—endoscopic portion); '057 Patent, Col. 3, lines 37-41 (claim element 1b)i)—clip storing means); 057 Patent, Col. 3, lines 42-51, '420 Patent, Col. 14, lines 9-12 (claim element 1b)ii)—clip advancing means; '420 Patent, Col. 4, lines 23-25 (claim element 1b)iii)—clip closing means); '420 Patent, Col. 4, line 64 through Col. 5, line 1, Col. 5, lines 4-17 (claim element 1b)iv) —gaseous sealing means).

3. *Claim 2 of the '057 Patent (PPI 39)*

Claim 2 of the '057 Patent reads in full: "The apparatus according to Claim 1 wherein said gaseous seal means comprises silicone grease." Claim 2 of the '057 Patent is a dependent claim. As I explained earlier, a dependent claim includes a reference to at least one other claim in the patent. In this case, Claim 2 of the '057 Patent makes reference to Claim 1 of the '057 Patent by the phrase "the apparatus according to claim 1." As a dependent claim, Claim 2 incorporates all of the limitations contained in Claim 1 which I have just interpreted for you. Claim 2 also includes an additional element. All the elements of Claims 1 and 2 must be present before infringement of Claim 2 can be found.

The additional element of Claim 2 reads "said gaseous seal means comprises silicone grease." I interpret this as a structure claim which requires the use of silicone grease as part of the seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed.

In order to find that Claim 2 of the '057 Patent has been infringed by defendants' accused devices, you must first find that defendants' accused devices contain all of the claim elements of Claim 1 of the '057 Patent as I have interpreted them. Then you must find that defendants' accused devices also contain silicone grease as part of the seal.

4. *Claim 7 of the '057 Patent (PPI 40)*

Claim 7 of the '057 Patent reads in full:

A disposable apparatus for endoscopic application of surgical clips to body tissue which comprises:

a) a frame;

b) an elongated endoscopic section connected at the proximal end thereof to said frame and extending distally from said frame, said endoscopic section including:

i) means for storing a plurality of surgical clips;

ii) a pair of jaws positioned at the distal portion of said endoscopic section and adapted for reception of said clips;

iii) means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped;

iv) means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue; and

v) gaseous sealing means.

Claim 7 uses the preamble and transitional phrase "A disposable apparatus for endoscopic application of surgical clips to body tissue which comprises." I interpret the words "a disposable apparatus for endoscopic application of surgical clips to body tissue" to mean a disposable endoscopic multiple clip applier. Therefore, if you find that defendants' accused devices are disposable endoscopic multiple clip appliers, then the preamble of claim 7 of the '057 Patent has been met. As I explained earlier, the word "comprises" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended. The presence of additional components in the accused product is irrelevant to whether the product infringes the patent claim. Therefore, if you find that defendants' accused devices contain all of the elements in Claim 7 and, in addition, defendants' accused devices contain additional components, defendants' accused devices still infringe the claim.

Claim element 7a) reads "a frame." I interpret this structure claim element to mean a housing for the non-endoscopic body of the apparatus. This claim element pertains only to the outer portion of the instrument body. It does not include the activating handle or release button of the claimed instrument or any of the parts inside the frame. Therefore, if you find that defendants' accused devices have a housing for the non-endoscopic body of the instrument, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

The initial portion of the next claim element—7b)—reads "an elongated endoscopic section connected at the proximal end thereof to said frame and extending distally from said frame." I interpret this structure claim element to mean an endoscopic section connected to the frame at its proximal end and extending away from the frame. Therefore, if you find that the defendants' accused devices have an endoscopic section connected to the frame at its proximal end and extending away from the frame, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

Claim elements 7b)i), 7b)ii), 7b)iii), 7b)iv), and 7b)v) are further elements which are part of and included in the endoscopic portion.

Clause i) of claim element 7b) reads "means for storing a plurality of surgical clips." This is a means-plus-function claim element. The stated function, as I interpret it, is to store a plurality of surgical clips. The structure or means disclosed in the patent specification for performing this function is a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument.

In order to find that this claim element of the '057 Patent has been met, you must find that the defendants' accused devices perform the function of storing a plurality of surgical clips. Then you must find that the defendants'

accused devices have a clip track which holds an array of surgical clips and a spring to bias the clips toward the distal or far end of the instrument, or equivalent structure, which perform this function.

Clause ii) of claim element 7b) reads "a pair of jaws positioned at the distal portion of said endoscopic section and adapted for reception of said clips." I interpret this structure claim element to mean a pair of jaws adapted to receive surgical clips. Therefore, if you find that defendants' accused devices have a pair of jaws adapted to receive surgical clips, then the defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

Clause iii) of claim 7b) reads "means for individually advancing said clips distally for positioning within said pair of jaws to be positioned adjacent the body tissue to be clipped." This is a means-plus-function claim element. The stated function, as I interpret it, is to advance clips one at a time to the jaws. The structure or means described in the patent specification for performing this function is a pusher bar and escapement tabs extending into the path of the clips.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of advancing clips one at a time to the jaws. Then you must find that the defendants' accused devices have a pusher bar and escapement tabs extending into the path of the clips, or equivalent structure, which perform this function.

Clause iv) of claim element 7b) reads "means for at least partially closing said jaws about each said clip to close said clips at least partially about the body tissue." This is a means-plus-function claim element. The stated function, as I interpret it, is to at least partially close the jaws to at least partially close the surgical clips about the body tissue. The structure or means described in the patent specification for performing this function is a dis-

tally-moving cam channel capable of at least partially closing the jaws.

In order for you to find that this claim element of the '057 Patent has been met, you must first find that the defendants' accused devices perform the function of at least partially closing the jaws to at least partially close the surgical clips about the body tissue. Then you must find that the defendants' accused devices have a distally-moving cam channel capable of at least partially closing the jaws, or equivalent structure, which performs this function.

The final clause v) of claim element 7b) reads "gaseous sealing means." I interpret this as a structure claim element which requires a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed. Therefore, if you find that defendants' accused devices have a seal to obstruct the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed, then defendants' accused devices satisfy this element of Claim 7 of the '057 Patent.

5. *Inventor As Lexicographer (PPI 41)*

Because it is often difficult to describe a novel invention in words, the patent law allows an inventor to be his or her own lexicographer. This means that an inventor has a verbal license to define the terms that appear in the patent claims. If the inventor defines a word used in a patent claim in the specification, that definition is controlling.

'057 Patent, Abstract, '420 Patent, Col. 4, lines 7-10, Col. 2, lines 67-68 (claim element 7a)—frame); '057 Patent, Col. 5, lines 11-13 (claim element 7b)—endoscopic portion); '057 Patent, Col. 3, lines 37-41 (claim element 7b)i)—clip storing means); '057 Patent, Col. 3, lines 42-51 (claim element 7b)iii)—clip advancing means); '057 Patent, Col. 8, lines 6-8, '420 Patent, Col. 8, lines 45-46 (claim element 7b)iv)—clip closing means); '420 Patent, Col. 5, lines 4-17 (claim element 7b)v)—gaseous sealing means).

In light of this patent law principle, I have instructed you on the meaning of each structure claim element in the '420 and '057 Patents. For the structure claim elements, you must decide whether the accused devices have these structures as I have defined them.

For each means-plus-function claim element, I have instructed you on the corresponding structure in the '420 and '057 specifications for performing the stated function. For the means-plus-function claim elements, it is your job to decide whether the corresponding structure for performing the stated function, as I have defined it, or its equivalent exists in the accused devices. If other structure exists in defendants' accused devices which assists in performing the stated function of a particular claim element, that is not relevant to the question of infringement because it is not part of the claim element as defined by the inventor.

In addition, if the structure in the accused devices for performing the stated function of a claim element also performs an additional function, that is not relevant to the question of infringement because the additional function is not part of the claim element as defined by the inventor.

6. *Infringer Cannot Avoid Infringement By Making Modifications If All Claim Elements Are Met (PPI 42)*

As I explained earlier, when you are deciding whether defendants accused devices satisfy the means-plus-function

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McGill Inc. v. John Zink Co., 736 F.2d 666, 674 (Fed. Cir.), ("Words which were defined in the specification must be given the same meaning when used in a claim"), *cert. denied*, 469 U.S. 1037 (1984); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988); *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993); *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1481-82 (Fed. Cir.), *cert. denied*, 469 U.S. 924 (1984).

claim elements of plaintiff U.S. Surgical's patent claims at issue, you must first decide whether defendants' accused devices perform the stated function of a means-plus-function claim element. Then you must decide whether the accused devices perform that function by structure that is the same as or equivalent to the corresponding structure disclosed in the patent specification. The structure in the accused devices need not be identical to the structure disclosed in the patent specification for performing the stated function in order to satisfy the claim element. The only issue for you to decide with respect to these claim elements is whether defendants' accused devices have the required structure for performing the stated function.

7. *"Clip Closing Means" (PPI 43)*

Defendants have presented expert testimony that their accused devices do not satisfy the limitation in means-plus-function claim element 1 b)ii) of the '420 Patent calling for "clip closing means for sequentially closing said surgical clips." Defendants' expert offered a number of reasons why the structure in the accused devices for performing the function of closing surgical clips one after another and one at a time is not the same or equivalent. Defendants' expert said that the accused devices contain differently configured jaws than the U.S. Surgical jaws. The configuration of the jaws, however, bears no relevance to your determination of whether this claim element has been satisfied. The specific structure of the jaws is not part of the claim element because the claim element does not include how the jaws abut when cammed together, the width of the jaws, or how the forces of the jaws are applied to clips. The structure described in the patent specification for performing the

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Valmont Indus., Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042 (Fed. Cir. 1993); *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1575 (Fed. Cir. 1985).

function of closing surgical clips one at a time and one after another is simply flexible opposing jaws and a distally-moving cam channel.

In addition, defendants' expert testified that the activivating handle and other structure attached to the frame perform the function of sequentially closing surgical clips. You may not consider structure such as the activating handle because that structure is not within the shaft or endoscopic portion and because it is not part of the clip closing means. The clip closing means claim limitation refers only to structure within the endoscopic portion. Therefore, you must look only to the structure within the endoscopic portion of defendants' accused devices for performing the function of closing surgical clips one after another and one at a time to determine whether it is the same or equivalent to the structure described in the patent specification.

As I explained earlier, the patent law allows an inventor to be his or her own lexicographer. An inventor can define the relevant structure for performing a stated function in any way he or she wants. While other structure may in fact assist in performing the stated function of a means-plus-function claim, you must consider only the structure specified by the inventor for performing the function of a particular claim element. Therefore, while the activating handle of defendants' accused devices must be squeezed to cam the jaws shut, the activating handle is not part of the structure that performs the function of closing surgical clips one after another and one at a time. The claim element is limited to structure in the endoscopic portion and is specifically defined as flexible opposing jaws which are cammed together into closure by a distally moving cam channel.

ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1580 (Fed. Cir. 1988).

8. *"Seal Means" (PPI 44)*

With respect to the means-plus-function claim element in Claim 1 of the '420 Patent reciting "seal means . . . to obstruct passage of gaseous media from the body cavity," defendants have offered expert testimony that the structure in defendants' accused devices for obstructing the passage of gas from the body cavity is not the same as or equivalent to the structure described in the specifications of U.S. Surgical's patents. Defendants' expert testified that the accused devices have a central chamber and a series of additional chambers which serve other functions apart from sealing. Defendants' expert testified that the additional chambers serve as overflow for any grease that migrates from the central chamber as the feed bar and cam channel in defendants' accused devices move back and forth. He also testified that the chambers function to store body fluid that may come into the accused devices during a surgical procedure.

The additional structure identified by defendants' expert, such as a multi-chamber system to prevent the migration of silicone grease, does not mean that defendants' accused devices do not have sealing means as recited in the claims. It is irrelevant to the question of infringement that the additional structure in the accused devices performs added functions, such as reducing pressure or capturing grease or body fluids, or assisting or improving in sealing. The only question you must answer for this claim element is whether defendants' accused devices include structure that provide close tolerances with the internal moving parts of the endoscopic portion, such as a seal block with silicone grease, or equivalent structure, which perform the function of obstructing the passage of gas from the body cavity sufficiently so that the surgical procedure can be performed.

ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1580 (Fed. Cir. 1988); *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 750 F.2d 1569, 1580-81 (Fed. Cir. 1984).

9. *"Clip Advancing Means" (PPI 45)*

Defendants' expert has testified that the pusher bar in the accused devices for performing the function expressed as advancing or individually advancing the clips from clip storage to the jaws is not the same as or equivalent to the structure described in U.S. Surgical's patent specifications.

Defendants' expert pointed out that the pusher bar in the accused devices is wider than the pusher bar disclosed in the U.S. Surgical patent drawings and pushes the clips at a point further from the center axis of the clip. These differences are irrelevant to the question of infringement because these structural details are neither set forth in nor required by the claim elements themselves. The claim elements merely require a pusher bar. The dimensions of the pusher bar are irrelevant so long as the pusher bar in defendants' accused devices functions to advance or individually advance the clips from clip storage to the jaws.

The other difference highlighted during the testimony of defendants' expert is that the pusher bar depicted in U.S. Surgical's patent is in two planes while the Ethicon pusher bar is in one plane. This difference is irrelevant to these claim elements because the claim elements merely require that the pusher bar individually advance the clips from clip storage to the jaws. If you find that defendants' accused devices have a pusher bar which performs the function of individually advancing the clips from clip storage into the jaws, then the claim elements are satisfied.

10. *Automatic v. Semi-Automatic (PPI 46)*

U.S. Surgical's patent claims at issue in this case do not address whether the clip is advanced immediately or automatically upon release of the activating handle, as in the defendants' accused devices, or whether they are advanced after releasing a safety mechanism, or semi-

automatically, as in the U.S. Surgical device. As I mentioned earlier, a patent claim need not include every element or every structure in a claimed device. Since the question of the automatic versus the semi-automatic feature is not part of the claims at issue here, this difference is not relevant to your analysis of whether defendants' accused devices infringe U.S. Surgical's patents either literally or under the doctrine of equivalents. I will discuss the two types of infringement in a moment.

11. *Relevant Structure in Endoscopic Portion (PPI 47)*

When you are comparing defendants' accused devices to U.S. Surgical's patent claims, you will be mainly focused on analyzing structure within the endoscopic portion of defendants' accused devices. This is because the vast majority of structure claim elements and means-plus-function claim elements at issue all pertain to the endoscopic portion. For example, in Claim 1 of the '057 Patent, the only claim element which requires you to look at the non-endoscopic portion of defendants' accused devices is claim element 1a) calling out "frame means." All of the remaining claim elements are sub-elements of claim element b) which relates only to the endoscopic means. Therefore, the relevant structure in the accused devices for determining infringement of the claim elements for clip storing means, clip advancing means, clip closing means, and gaseous sealing means in my example of Claim 1 of the '057 Patent must be located in the endoscopic portion of the accused devices.

The only claim elements which require you to consider structure in defendants' accused devices in the non-endoscopic portion are the claim elements in all of the

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'057 Patent, Claim 13, Col. 18, lines 15-18; *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 699 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984); *Black & Decker, Inc., v. Hoover Service Ctr.*, 765 F. Supp. 1129 (D. Conn. 1991).

claims relating to the frame of the claimed invention. One exception is the claim element for seal means in Claim 1 of the '420 Patent, as the seal means in this claim is not limited to the endoscopic portion but could be found within the non-endoscopic portion of the instrument. The only other exception is the claim element of Claim 1 of the '420 Patent directed to a trocar for receiving the endoscopic multiple clip applier.

7. *Cumulative Open Multiple Clip Applier Art (PPI 61a)*

You should understand that in this case, you do not need to decide whether the patent examiner had before him all relevant prior art concerning non-endoscopic "open" multiple clip appliers. The patent examiner had before him sufficient open multiple clip applier art. In particular, the examiner had in the record before him the Montgomery '373 patent, the Premium Surgiclip brochure, and various other prior art references that you have heard evidence about. For the examiner's purposes the additional open multiple clip applier art that was not before him, including the patent covering the Premium Surgiclip device (Green '226), was merely cumulative of the prior art considered by the examiner and, therefore, not material to his decision. Accordingly, the fact that the examiner considered the Premium Surgiclip brochure and not the Green '226 Patent, and that there existed in the prior art other open multiple clip appliers that were not considered by the examiner has no effect on the presumption that U.S. Surgical's patents are nonobvious and does not make the presumption easier to overcome.

Although such cumulative open multiple clip applier prior art has no effect on the presumption of validity, should you find it relevant, you should consider such art when evaluating the obviousness question.

Recommended Ruling On Plaintiff's Motion For Summary Judgment On The Issue Of Alleged Inequitable Conduct, pp. 16-19, 21-22

9. *Prior Art References That Teach Away (PPI 72)*

You may find that there are disclosures in the prior art relied on by defendants that teach the opposite idea, or away from, the inventions claimed in U.S. Surgical's patents. Where a prior art reference teaches away from the claimed invention, you should consider this as evidence that the claimed invention is nonobvious over the prior art.

20. *Absence of Secondary Considerations is a Neutral Factor (PPI 83)*

While the presence of secondary considerations may be strong evidence supporting nonobviousness, the absence of secondary considerations is in no way suggestive of obviousness of invalidity. Thus, you should not consider evidence presented by defendants to show the absence of secondary considerations as evidence of obviousness. If you credit this evidence at all, you should consider it only for whatever bearing it may have on whether U.S. Surgical established the existence of secondary considerations in support of nonobviousness.

21. *What is Not Evidence of Obviousness (PPI 84)*

The patent statutes specifically provide that "patentability shall not be negatived by the manner in which the invention was made." What this means is that evidence of how an invention was made, or how long or short

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(February 11, 1993) (holding that open multiple clip applier art beyond the Premium Surgiclip brochure, Montgomery '373, and McGarry '254 was cumulative).

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 301 (Fed. Cir. 1985).

Medtronic, Inc. v. Intermedics, Inc., 799 F.2d 734, 739 & n. 13 (Fed Cir. 1986), *cert. denied*, 479 U.S. 1033 (1987); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 960 (Fed. Cir. 1986).

a time it took to make it, is immaterial to whether the invention is obvious.

Likewise, how obvious U.S. Surgical's invention may have seemed to U.S. Surgical's own inventors should not be considered by you in determining whether the invention was obvious. As I have stated, the test for obviousness is whether the invention would have been obvious to a *hypothetical* person of ordinary skill—not whether it would have been obvious to the actual inventors who conceived of and developed the patented invention. The law does not allow the inventors' own work to be used against them.

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35 U.S.C. § 103; *Shiley Inc. v. Bentley Laboratories, Inc.*, 794 F.2d 1561, 1568 (Fed. Cir. 1986); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 874 (Fed. Cir. 1985); *Standard Oil v. American Cyanamid*, 774 F.2d 448, 454 (Fed. Cir. 1985); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986), *cert. denied* 484 U.S. 823 (1987).

APPENDIX C

EXCERPTS CLOSING ARGUMENTS
(District Court, Feb. 10, 1994)

In closing, Ethicon's trial counsel (Mr. Diskant) argued as follows:

> I also told you at the outset that if these patents were construed to be as broad as U.S. Surgical says they are, to cover any endoscopic multiple clip applier that has a frame and a shaft and jaws and clips and a seal, well, then it would be obvious and invalid, and I think we've proved that, too. A. 666 (Tr. 2669).
>
> * * * *
>
> If you construe the patent this way, we don't infringe. We don't have those structures, we don't have the equivalents to those structures. The other way you can look at it is their way. Doesn't matter what the structures are. *Any* jaws, *any* pusher bar, *any* feed system, *any* escapement, that's what they say is described in their patents, and then, of course, because it's a means plus function claim, they also get the equivalents. *Any jaws plus equivalents, any pusher bar plus equivalents, any feed system plus equivalents. That's everything.* There's nothing left, if that's the way you construe a patent. But if that's what the patent is, it doesn't matter what they invented. It's really just an obvious conception. It's an invalid patent.
>
> So respectfully we submit we win either way you analyze it. You look at it narrowly as we suggest what we think is right, they've got a valid patent, but we don't infringe. *You look at it their way, their patent is hopeless.* A. 673 (Tr. 2709) (italics added).

In closing, U.S. Surgical's trial counsel (Mr. McDaniels) responded as follows:

> U.S. Surgical's invention is not a patent on any endoscopic multiple clip applier. It is a patent on an endoscopic multiple clip applier that has in its endoscopic section *the particular means* for clip storage, both clip advancing, and clip closing that is *set forth in the patent and in the definitions of the patent*. That is what is protected. A. 673 (Tr. 2710-11) (italics and underlining added).